

REMARKS

Reconsideration of the present application, as amended, is respectfully requested. As requested, a substitute abstract has been provided. All of the pending claims have been amended to address the minor informalities noted in the Action and to clearly limit the claimed invention to bone nails. The first paragraph is amended to add a specific reference to conform to the priority data contained in PTO records. The rejections are traversed and all pending claims are seen to be in condition for allowance.

In an effort to speed prosecution of this case, The Examiner is respectfully urged to call the undersigned prior to issuing any further office actions in this case.

Claim Rejections: 102(b)

Claims 1-13, 15-19 and 27-28 stand rejected under 102(b) as being anticipated by Naybour. A rejection may be based on 35 U.S.C. 102(b) only when the asserted reference was published more than 1 year prior to the effective filing date of the application. The issue date of Naybour is March 13, 2001, which is plainly not more than one year prior to Applicant's priority date. Therefore, Naybour cannot properly support a rejection under 102(b), and the rejection must be withdrawn.

To the extent Naybour is considered prior art to the present case, which Applicant does not admit, Applicant respectfully notes that, as amended, all pending claims in this case are directed to bone nails. Naybour discloses stem configurations for a prosthetic hip, shoulder, or

knee. Nothing in Naybour is seen to teach or suggest any structure suitable for use as a bone nail.

Bone nails, as is known in the art, are designed to remain in place while a fracture heals and then preferably be withdrawn. Naybour's prostheses stems are designed for permanent fixation in bone cavities. As a result, Naybour does not address the problem of how to controllably reverse the expansion of the distal portion 4 so as to facilitate withdrawal of the stem from the bone cavity at the end of the treatment period.

In fact, it is not entirely clear how Naybour intends the expansion of the distal portion 4 to be accomplished in the first place. The relevant description of Naybour seems to be that "The hip stem 1 is expanded by applying pressure along the longitudinal length of the hip stem 1 as shown in FIG. 3" (col. 3, lines 34-37) or that "Pressure can be applied internally to expand the hip stem 1 as shown in FIG. 6" (col. 3, lines 47-48), but Naybour is not seen to point to any structure in the distal portion 4 that actually applies the relevant expansion pressure. In contrast, Applicant's claims recite that the force is applied via a nose portion and an opposing portion coupled via a tie rod. Accordingly, a rejection based on Naybour cannot be maintained.

Regarding the rejection of claim 13, Applicant has carefully reviewed Naybour and fails to see any disclosure that the profile of Naybour's expansion portions are either stepped or curved. By way of contrast, Applicant's disclosure shows a variety of specific stepped and/or curved profiles in, for example, Figures 2 (a)-(e).

Claim 14 stands rejected under 103(a) as being unpatentable over Naybour in view of Gianezio.

For the reasons discussed above, the rejection based on Naybour is improper and must be withdrawn. Moreover, applicant notes that Gianezio, like Naybour, also seems to be directed to prostheses stems and not bone nails.

Reconsideration of the application, as amended, is respectfully requested. If there are any remaining issues that can be addressed by phone or otherwise, the Examiner is invited to contact the undersigned directly.

Respectfully submitted,

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